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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,289	04/07/2000	YAACOV ALMOG	UDS	5383

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EXAMINER
XU, LING X

ART UNIT	PAPER NUMBER
1774	14

DATE MAILED: 03/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-14

Office Action Summary	Application No. 09/529,289	Applicant(s) ALMOG ET AL.	
	Examiner Ling X. Xu	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 February 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,7-12,14-30,32,37-42 and 45* is/are pending in the application.

4a) Of the above claim(s) *7-10,12,19,21,22,30,37-41 and 45* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3, 11, 14-18, 20, 23-29, 32, 42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. Applicants' amendments filed on 2/1/2002 have been entered. Claims 43-44 have been cancelled. The present application contains claims 1-3, 7-12, 14-30, 32, 37-42 and 45. In light of applicants' amendments, previous rejection based on 35 USC 102 (b) is now withdrawn. However, the rejection of claims 1-3, 11, 14-18, 20, 23-29, 32, and 42 based on 35 USC 103 (a) and rejection of claim 11 based on 35 USC 112(2) still stand.

Lack of Unities Election/Restrictions

2. Applicants' petition file 1/10/2002 requesting that the examiner's finding of lack of unity of inventions between Group I, II and III be vacated has been denied by the Director of the Technology Center 1700. The Examiner maintains the lack of unity requirement made in the previous Office action of 10/10/2001 in Paper No. 9.

Claims 1-3, 11, 14-18, 20, 23-29, 32 and 42 read on the elected species. Claims 7-10, 12, 19, 21-22, 30, 37-41 and 45 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions for the reason of record in Paper No. 9.

Claim Rejections - 35 USC § 112

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 11 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the reason of record of Paper No. 9.

Claim Rejections - 35 USC § 103

4. Claims 1-3, 11, 14-18, 20, 23-29, 32, and 42 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Touhsaent et al in view of Ueno et al. for the reason of record in Paper No.9.

Response to Arguments

5. With respect to rejections based on 35 USC 112(2), applicants argue that the term of BOPP is a term of the art for biaxially oriented polypropylene. Applicants rely on the fact that the Examiner correctly identified this material in the Touhsaent reference to support such argument. However, there are two separate requirements for claims under 35 USC 112(2):

(A) The claims must set forth the subject matter that applicants regard as their invention; and

(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

Applicants fail to particularly point out and distinctly define the term BOPP in the claim. The specification does not provide any definition for this term. Therefore, the scope of the claim is not clear and precise. The fact that the Examiner correctly identified the material in one single prior art is insufficient to prove that the claim is clear and precise because the examination was based on the Examiner's presumption according to one single prior art.

With respect to the argument that all of the unrestricted claims have been rejected under 35 USC 112(2) including claims 1, 25-27 and 45, the examiner did not reject all of the unrestricted claims under 35 USC 112(2), only the claims read on the elected species were considered. The examiner is now withdrawn rejections of claims 1 and 25-27 under 35 USC 112(2). Claim 45 has never been rejected because it was withdrawn from further consideration as being drawn to non-elected invention.

6. Applicant's arguments with respect to rejections based on 35 USC 102(b) have been considered but are moot in light of Applicants' amendment including cancellation of claims 43-44.

7. Applicant's arguments with respect to rejections based on 35 USC 103(a) have been fully considered but they are not persuasive.

Applicants argue that the Touhsaent and Ueno are not combinable because Ueno is concerned with a different technology from Touhsaent's reference. The Examiner disagrees. Touhsaent discloses a coating composition which can be used in any substrate. In another words, Touhsaent does not limit the coating composition from using on a substrate in the transfer sheet disclosed by Uneo.

Applicants also argue that the primers layer does not include the underlayer materials that are claimed in claims 1 and 42. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As stated in the prior Office action, Ueno teaches the use of an adhesive layer made of polyamide resins with excellent adhesion to the substrate. Therefore, it would have been obvious to one of ordinary skill in the art to use polyamide resins as adhesive material for Tousaent's intermediate primer coating layer because polyamide resins provide excellent adhesion to the substrate, as taught by Ueno. The combination of Tousaent and Ueno teaches the claimed composition.

Applicants also argue that there is no hint that the adhesive of Ueno would adhere to the substrate on which it is coated. First, Touhsaent does not state that the primer layer should provide good adhesion to the material on which it is coated as indicated by the applicants. Second, the materials used in Touhsaent and Ueno for

substrates are similar materials and therefore, one skilled in the art would reasonably believer, that the adhesive layer with amine terminated polyamide should work as well in Touhsaent's substrate.

The Examiner disagree with applicant's assertion that Ueno does not teach the adhesive should not adhere to the substrate on which it is coated. Ueno clearly indicates that the adhesive layer is on the substrate. It is irrelevant how the adhesive adhere to the substrate, whether it is by heat, pressure or other means, the fact that it is an adhesive layer on the substrate is what should be concerned.

The examiner also disagrees with applicants' assertion that Ueno provides a release material is to assure the lack of adhesion (applicants fail to provide the number of the column in Ueno to support this assertion). On the contrary, because the adhesive layer provides excellent adhesion to the substrate, a release material layer is provided (Col. 5, lines 25-30) to improve the release effect and assure that the adhesive layer and the substrate are transferable. The release materials layer is provided to improve release effect between the substrate and the adhesive layer at the time of transfer of the adhesive layer (Col. 5, lines 25-30). Accordingly, Ueno is not teaching away from the present invention.

Applicants argue that the interposing layer of Ueno uses different materials form the layer of Touhsaent. Once again, applicants attack references individually where the rejections are based on combinations of references. What material used in Ueno for other layers, such as the interposing layer is irrelevant because the open language "comprising" is used in the claims. What is relevant is that Ueno, as a secondly

reference, provides suggestion and motivation to use the adhesive layer made of polyamide resins with excellent adhesion to Touhsaent's substrate as the intermediate primer or underlayer.

Applicants also argue that claims 2-3 contain features that are not taught by Touhsaent or Ueno, such as claim 2 defines the overlayer as being free of particlulate matter and claim 3 defines the overlayer as being wax free. However, Touhsaent only suggests that the coating is preferred to have particulate matter and wax materials. A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. Merck & Co. v.Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir.1998). "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." In re Heck, 699 F.2d 1331, 1332-33,216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006,1009, 158 USPQ 275, 277 (CCPA 1968)).

With respect to argument regarding claims 12, 19 and 21-22. These claims have not been considered because these claims remain withdrawn from consideration as being drawn to non-elected invention.

Conclusion

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ling X. Xu whose telephone number is 703-305-0395. The examiner can normally be reached on 8:00 - 4:30 Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 703-308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

lx

LX

March 20, 2002

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700